

## REMARKS

### Restriction Requirement

The Examiner issued an Office Action on January 16, 2003, subjecting claims 1-16 to a restriction requirement. The Examiner divided the claims into two groups and characterized claims 1-11 and 12-16 as being directed to "face recognition" and "a sound control toy," respectively. The Examiner further characterized the two groups of claims as being related as combination and subcombination.

The Applicants respectfully traverse the restriction requirement. Claim 12 is not drawn to a "sound control toy." On the contrary, claim 12, like claim 1, is drawn to face recognition. Only dependent claims 13-16 add limitations related to sound controls.

The following chart compares and matches the elements of claims 1 and 12.

Claim 1	Claim 12
An <i>interactive entertainment apparatus</i> comprising: an <i>entertainment device</i> positionable in proximity to animate and inanimate objects	A <i>toy</i> comprising:
an <i>acquisition device</i> associated with said entertainment device, said <i>acquisition device</i> being adapted to acquire a representation of a facial characteristic of an object in proximity to said entertainment device, and said acquisition device being adapted to produce a signal relative to the acquired representation; and	a <i>camera and digitizer</i> for acquiring a representation of a facial image;
a <i>processor</i> associated with said acquisition device in a manner to receive the produced signal from said acquisition device,	a <i>CPU</i> associated with said camera and digitizer and capable of manipulating signals therefrom;
said <i>processor</i> being adapted to compare the produced signal relative to data stored in memory and to provide an output signal indicative of recognition.	<i>software</i> resident on said CPU for locating and recognizing said facial images and providing an output signal indicative of recognition

MPEP § 806.05(c) states that “[i]n order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.”

Applicants respectfully submit that two-way distinctness is not present here, because:

- the “toy” of claim 12, together with its camera and output signal, is by definition a type of “interactive entertainment apparatus” and “entertainment device” that is positionable in proximity to animate and inanimate objects;
- the “camera and digitizer” of claim 12 is by definition a type of “acquisition device;”
- by “acquiring a representation of a facial image,” the camera and digitizer of claim 12 by definition meets claim 1’s limitation of “being adapted to acquire a representation of a facial characteristic”;
- the “camera and digitizer” of claim 12 by definition satisfies the limitation of “produc[ing] a signal relative to the acquired representation” (claim 1);
- a “CPU” (claim 12) is a type of “processor” (claim 1); and
- “software” (claim 12) is an adaptation of a processor (claim 1) – *see In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (“We have held that such programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software.”).

Here, two-way distinctness cannot be demonstrated. Because claim 1 is broader than claim 12, it may well be patentably distinct from claim 12. But claim 12 is not patentably distinct from claim 1. It would be impossible to infringe claim 12 without infringing claim 1. Indeed, claim 12 could have been drafted as follows, as a claim depending from claim 1, without affecting the scope of claim 12:

*Claim 12 (hypothetical): The interactive entertainment device of claim 1, wherein:*

*the entertainment device comprises a toy;*

*the acquisition device comprises a camera and a digitizer;*

*the facial characteristic is a facial image;*

*the processor is a CPU capable of manipulating signals received from the camera and digitizer; and*

*the processor is adapted through software resident on the processor.*

Applicants simply drafted claim 12 in a more elegant manner. Applicants respectfully submit that claim 12, as written, is much to be preferred over the hypothetical claim presented above.

Applicants respectfully ask that the Examiner reconsider and withdraw the restriction requirement. Nevertheless, the Applicants provisionally elect the claims in group I (claims 1-11).

#### **Amendment to the Specification**

As noted above, the undersigned has been informed that the original application omitted a "Related Applications" section claiming priority to Provisional Patent Application Serial No. 60/116,391 filed January 19, 1999.<sup>1</sup> 37 C.F.R. § 1.78(a)(5) permits amendment of a nonprovisional application to include a claim of priority. Fortunately, the recently imposed 4-month/16-month deadline for making such an amendment does not apply because the application was filed before November 29, 2000. See 37 C.F.R. § 1.78(a)(5)(ii)(A).

#### **Conclusion**

Believing that all things raised in the Examiner's January 16, 2003, Office Action have been addressed, the undersigned respectfully requests swift action on the merits of the application.

Respectfully submitted,

*Eric W. Cernyar*

Eric W. Cernyar

Reg. No. 45,919

(210) 863-0063

---

<sup>1</sup> If that information is incorrect, please disregard the requested amendment to the specification.